



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/266,183	03/10/1999	MARCO SCIBORA	90020-12	5426

32300 7590 10/06/2005

BRIGGS AND MORGAN P.A.
2200 IDS CENTER
80 SOUTH 8TH ST
MINNEAPOLIS, MN 55402

EXAMINER

FLANDERS, ANDREW C

ART UNIT PAPER NUMBER

2644

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAILED

OCT 06 2005

Technology Center 2600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/266,183
Filing Date: March 10, 1999
Appellant(s): SCIBORA, MARCO

Gerald E. Helget
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 30 August 2005 appealing from the Office
action mailed 03 May 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Related Proceedings Appendix

No related proceedings are listed within the Related Proceedings Appendix.

(10) References of Record

Tsevdos (U.S. Patent 5,734,719), Alexander (U.S. Patent 5,633,839), Kaplan (U.S. Patent 5,734,719), Salisbury (U.S. Patent 6,041,703), Hwang (U.S. Patent 5,825,726) and Cook (U.S. Patent 5,860,068).

(11) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsevdos (U.S. Patent 5,734,719) in view of Alexander (U.S. Patent 5,633,839)

Regarding **Claim 1**, Tsevdos discloses a plurality of preview stations distributed throughout the retail premise (Fig. 14 elements 1303), a plurality of compact disc cutters (Fig. 14 elements 1318), retail host server connected to booths and cd-r's (Fig. 14 element 1408) (i.e. a main computer connected to the memory, to the preview stations and to the compact disc cutters). Tsevdos does not disclose a music memory

Art Unit: 2644

containing a plurality of digitally stored music selections. Alexander discloses a music vending machine with a disk drive that is a removable hard drive which contains digitally stored musical selections (col. 2 lines 64 – 65) (i.e. a music memory containing a plurality of digitally stored music selections). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Alexander's Music vending machine within Tsevdos' music preview stations to increase the functionality of Tsevdos' system. Alexander discloses if a consumer wishes to own a compact disc recording of his or her favorite musical selections, the consumer either has to buy the entire CD, a single CD, or buy an expensive CD recording system and record off of radio (col. 1 lines 12 – 37). Alexander's solution is to allow a customer to select multiple music selections and record it to a compact disc (col. 1 lines 58 – 65) rather than have to use one of the three above options. It would be desirable to have this feature available on Tsevdos' system to allow a consumer to custom record a disc with personalized selections.

Regarding **Claim 2**, in addition to the elements stated above regarding claim 1, Alexander further discloses a music vending machine with a disk drive that is a removable hard drive which contains digitally stored musical selections (col. 2 lines 64 – 65) (i.e. wherein the memory comprises at least one hard disc drive).

Regarding **Claim 3**, in addition to the elements stated above regarding claim 1, Tsevdos discloses a system for accessing digital audio information at remotely stored

Art Unit: 2644

locations (col. 1 lines 18 – 20) (i.e. wherein the music memory is located remotely from the main computer).

Regarding **Claims 4 - 9**, in addition to the elements stated above regarding claim 1 storing music uncompressed, MP3, ADPCM, Real Audio, and Liquid audio encoding were all notoriously well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to compress the musical selections in order to save hard drive space. In addition, it would have been equally as obvious to not use compressed as stated in claim 4. One would have been motivated to do so to maintain a higher level of quality for the audio. Perceptual coding techniques such as MP3, ADPCM, Real Audio and Liquid audio typically involve some loss of quality during the encoding process.

Claims 10 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsevdos (U.S. Patent 5,734,719) in view of Alexander (U.S. Patent 5,633,839) and in further view of Kaplan (U.S. Patent 5,237,157)

Regarding **Claim 10**, in addition to the elements stated above regarding claim 1, Tsevdos discloses a monitor, a sound amplifier and speakers (Fig. 16 elements 1606, 1608 and 1610), compact disc purchase means (Fig. 27), track selection means (Fig. 25). Tsevdos does not disclose a bar code scanner. Kaplan discloses scanning a UPC bar code to bring up audio selections (col. 3 lines 12 – 21). It would have been obvious

Art Unit: 2644

to one of ordinary skill in the art at the time of the invention to add a bar code reader as taught by Kaplan to Tsevdos and Alexander's combination in order to facilitate customer selection of albums.

Regarding **Claim 11**, in addition to the elements stated above regarding claim 10, Tsevdos discloses speakers (Fig. 16 elements 1608).

Regarding **Claim 12**, in addition to the element stated above regarding claim 10, using headphones to reproduce sound was notoriously well known in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to use headphones instead of speakers as the sound reproduction device in order to prevent unnecessary noise throughout a retail environment.

Regarding **Claim 13**, in addition to the elements stated above regarding claim 10, Tsevdos further discloses track selection means with a skip forward and skip backward function (see arrows next to display on Fig. 25)

Regarding **Claim 14**, in addition to the elements stated above regarding claim 10, Tsevdos further discloses a screen with an order button (Fig. 28) (i.e. buy button).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander (U.S. Patent 5,633,839) in view of Tsevdos (U.S. Patent 5,734,719) and in

further view of Salisbury (U.S. Patent 6,041,703). The elements referred to from Salisbury are not part of applications 08/760,640 or 09/007,530 and thus receive the priority date of 10 March 1999.

Regarding **Claim 15** in addition to the elements stated above regarding claim 1, Alexander discloses a microprocessor that then directs the CD writer and dispenser to retrieve a blank compact disk (not shown) from a CD storage and to record the customer's selections onto the compact disk (col. 3 lines 45 – 52) (i.e. a storage for a number of blank compact discs, a mechanism for removing a blank compact disc from the compact disc from the compact disc storage and a mechanism for recording music selected from the music memory on a blank compact disc). Neither Alexander nor Tsevdos disclose a printer adapted to print identifying information on the compact disc. Salisbury discloses placing the compact disc into a printer for printing on a compact disc (i.e. a printer adapted to print identifying information on the compact disc). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Salisbury's printer with the Tsevdos and Alexander combination in order to create a retail compact disc. It would be desirable to print a design on a compact disc in order to mimic a standard pressed retail disc.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander (U.S. Patent 5,633,839) in view of Tsevdos (U.S. Patent 5,734,719) and in further view of Salisbury (U.S. Patent 6,041,703) and in further view of Hwang (U.S.

Patent 5,825,726). The elements referred to from Salisbury are not part of applications 08/760,640 or 09/007,530 and thus receive the priority date of 10 March 1999.

Regarding **Claim 16**, in addition to the elements listed above regarding claim 15, Hwang discloses a plurality of track data is recorded in respective sessions, and track information for the corresponding session is recorded in the lead in area of the corresponding session (col. 3 lines 38 – 41) (i.e. data of manufacture, retailer's name and the titles of the music selections are cut into the compact disc). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hwang's track information writing scheme on the Tsevdos and Alexander combination in order to conveniently locate where a disc was manufactured. It would be desirable to know the details of when the disc was produced for disc failure issues and customer warranty claims.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsevdos (U.S. Patent 5,734,719) in view of Alexander (U.S. Patent 5,633,839) and in further view of Cook (U.S. Patent 5,860,068). The elements referred to from Cook are not part of applications 08/760,640 or 09/007,530 and thus receive the priority date of 10 March 1999.

Regarding **Claim 17**, in addition to the elements listed above regarding claim 1, Cook discloses a gift card (column 5, lines 25 – 32) (i.e. a plurality of scannable

Art Unit: 2644

purchase cards each having a unique bar code keyed to the music selections chosen by the customer). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Cook's gift card on the Tsevdos and Alexander combination in order to conveniently purchase a CD. Cook's system does essential the same as the Tsevdos and Alexander combination and it would be desirable to add a gift card feature to facilitate a purchase by a third party.

Claims 18 - 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsevdos (U.S. Patent 5,734,719) in view of Alexander (U.S. Patent 5,633,839) and in further view of Kaplan (U.S. Patent 5,237,157) and in further view of Cook (U.S. Patent 5,860,068). The elements referred to from Cook are not part of applications 08/760,640 or 09/007,530 and thus receive the priority date of 10 March 1999.

Regarding **Claim 18**, Tsevdos discloses screens with selections and an order button (Figs. 19 - 28) (i.e. the customer selecting each track to be purchased, up to the authorized amount, by pressing a buy button at the preview station). Tsevdos does not disclose the customer obtaining a purchase card with a unique barcode number and an authorized amount from retail premises personnel, the customer scanning a disc barcode for a compact disc to be sampled at a preview station, playing each track corresponding to the disc barcode at the preview station, playing each track corresponding to the disc barcode at the preview station, scanning the purchase card to obtain the unique barcode, keying each selected track to the unique barcode, scanning the purchase card

Art Unit: 2644

at a checkout station to obtain the unique barcode or recording the selected tracks keyed to the unique barcode on a compact disc cutter. Alexander discloses a microprocessor that then directs the CD writer and dispenser to retrieve a blank compact disk (not shown) from a CD storage and to record the customer's selections onto the compact disk (col. 3 lines 45 – 52) (i.e. recording the selected tracks keyed to the unique barcode on a compact disc cutter). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Alexander's Music vending machine within Tsevdos' music preview stations to increase the functionality of Tsevdos' system. Alexander discloses if a consumer wishes to own a compact disc recording of his or her favorite musical selections, the consumer either has to buy the entire CD, a single CD, or buy an expensive CD recording system and record off of radio (col. 1 lines 12 – 37). Alexander's solution is to allow a customer to select multiple music selections and record it to a compact disc (col. 1 lines 58 – 65) rather than have to use one of the three above options. It would be desirable to have this feature available on Tsevdos' system to allow a consumer to custom record a disc with personalized selections. Neither Tsevdos nor Alexander disclose the customer obtaining a purchase card with a unique barcode number and an authorized amount from retail premises personnel, the customer scanning a disc barcode for a compact disc to be sampled at a preview station, playing each track corresponding to the disc barcode at the preview station, playing each track corresponding to the disc barcode at the preview station, scanning the purchase card to obtain the unique barcode, keying each selected track to the unique barcode, scanning the purchase card at a checkout

station to obtain the unique barcode. Cook discloses a gift card with a number and supplying the gift number to the machine (col. 5 lines 25 – 31) (i.e. the customer obtaining a purchase card with a unique barcode number and scanning the purchase card to obtain the unique barcode and scanning the purchase card at a checkout station to obtain the unique barcode) and a barcode as an identifier for each CD (col. 10 lines 25 – 40) (i.e. keying each selected track to the unique barcode). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Cook's gift card on the Tsevdos and Alexander combination in order to conveniently purchase a CD. Cook's system does essential the same as the Tsevdos and Alexander combination and it would be desirable to add a gift card feature to facilitate a purchase by a third party. Neither Tsevdos, Alexander or Cook disclose the customer scanning a disc barcode for a compact disc to be sampled at a preview station and playing each track corresponding to the disc barcode at the preview station. Kaplan discloses scanning a UPC bar code to bring up audio selections (col. 3 lines 12 – 21) (i.e. the customer scanning a disc barcode for a compact disc to be sampled at a preview station and playing each track corresponding to the disc barcode at the preview station). It would have been obvious to one of ordinary skill in the art at the time of the invention to add a bar code reader as taught by Kaplan to the Tsevdos, Alexander and Cook combination in order to facilitate customer selection of albums.

Regarding **Claim 19**, as shown above Kaplan and Alexander teach elements b, c, d, e, l, n, o, and p. Cook teaches a, h, j, k, l, and q. Tsevdos teaches f and g. The

motivation to combine these elements is stated above regarding claim 18 and thus, claim 19 is rejected.

Regarding **Claims 20 and 21**, the gift card of Cook is implicitly purchased either before or after the tracks are selected.

Claims 18 – 21 stand rejected under 35 U.S.C. § 103(a) over Tsevdos in view of Alexander and in further view of Kaplan and in further view of Cook for the reasons set forth in the Office action dated 03 May 2005.

(12) Response to Argument

In Section A of Appellant's arguments, Appellant states:

"The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of non-obviousness."

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the

Art Unit: 2644

claimed combination and the reasonable expectation of success must both be found in the prior art. and not based on applicant's disclosure."

"Applicant respectfully traverses the §103 rejection because the office action has not established a prima facie case of obviousness."

Examiner respectfully disagrees. As shown in the two prior actions the three basic criteria for a prima facie case of obviousness have been met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. As stated in the previous rejections, both the Alexander and Tsevdos teach similar inventions of purchasing compact discs at a retail location. The Tsevdos references allows a user to search for various albums by various queries and to preview them before purchase (see col. 3 lines 10 – 24 and Figs. 16 – 29). The purpose of the Tsevdos reference is to free up the retail space by removing the older and lesser selling albums and instead, having a potential customer of these albums purchase them remotely through the remote system (see col. 2 lines 43 – 54). Tsevdos does not disclose creating a custom CD. Tsevdos does have the means necessary to be adapted to create custom CD's, the preview stations, the compact disc cutters and the music (Fig. 14 elements 1303, 1318). Alexander discloses a music vending machine capable of recording a customer's music selections onto a compact disc. Thus, since Tsevdos has the means to operate in a manner disclosed by Alexander, It would have been obvious to take the elements from

Alexander and apply them to Tsevdos in order to further assist a customer in creating a custom compact disc. Alexander discloses if a consumer wishes to own a compact disc recording of his or her favorite musical selections, the consumer either has to buy the entire CD, a single CD, or buy an expensive CD recording system and record off of the radio (see Alexander col. 1 lines 12 – 37). Finally, one would have been motivated to do so in order to use Alexander's solution to allow a customer to select multiple music selections and record them to a compact disc (col. 1 lines 58 – 65 in Alexander) rather than have to use one of the three above options. While Tsevdos allows a customer to buy an album, Alexander discloses that even if the consumer is interested in 1 or 2 of the songs on the CD, he or she must pay for all of the selections. Adapting Tsevdos to operate like Alexander would avoid this expense and thus be desirable.

Thus, contrary to Appellant's argument, there is sufficient motivation to combine the features of Alexander into the Tsevdos disclosure.

Secondly, Appellant states that there must be a reasonable expectation of success. As shown above, the Tsevdos art contains the necessary features to operate in a manner to create custom CD's as disclosed by Alexander (see Fig. 14 elements 1303, 1318 in Tsevdos). This it would be reasonable for one with ordinary skill in the art to assume that the Tsevdos reference could be modified to operate as the custom CD creation station disclosed by Alexander.

Thirdly, Appellant states that the prior art reference (or references when combined) must teach or suggest all claim limitations. As shown in the previous rejection dated 03 May 2005, the combination meets all of the limitations of the claims under appeal.

Lastly, Appellant states that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. As shown above, there is sufficient evidence in the prior art to be motivated to adapt Tsevdos to create custom CD's as disclosed by Alexander. Tsevdos discloses means that could be modified to create the custom CDs (see Fig. 14 elements 1303, 1318 in Tsevdos) and Alexander discloses why a user would want to create custom CDs, (see Alexander col. 1 lines 10 – 47).

In Section A of Appellant's arguments, Appellant further states:

"In the Response to Arguments, the Examiner argues that Tsevdos is a continuation of an abandoned application with a priority date of 15 October 1993, and that a continuation relies on the entire disclosure of the prior application and thus teaches the invention. However, the Examiner has not cited any authority for this holding. Furthermore, the designation of an application as a continuation or a continuation-in-part is made by the Applicant. Sometimes continuation-in-part applications are accidentally designated as continuation applications for the express

purpose of preserving the priority date. Other times, an error is made. In any case, it is impossible to conclude that the earlier abandoned application teaches the invention without examining the abandoned application, which the Examiner has not done.

Therefore, Appellant maintains that Tsevdos 5,734,719 has not been shown to be prior art."

Examiner respectfully disagrees. Examiner cites MPEP Section 901.02 in which it states "It has also been held that where the reference patent refers to a previously copending but subsequently abandoned application which discloses the subject matter in common with the patent, the effective date of the reference as to the common subject matter is the filing date of the abandoned application." Thus, Tsevdos is prior art with a priority date of 15 October 1993. Further, Examiner has examined 08/763,308 (the abandoned application in question, previously numbered 137,880), and the disclosure and drawings contained within 08/763,308 match exactly the disclosure and drawings set forth in the Tsevdos reference. Thus there is no error as Appellant has purported since all references cited from Patent 5,734,719 exist in the previously abandoned application 137,880, now numbered 08/763,308 and thus according to MPEP section 901.02 the reference receives the priority date of 15 October 1993. As such the argument is moot.

In Section B of Appellant's arguments, Appellant states:

Appellant primarily argues in section B again that Tsevdos has not been shown to be prior art.

Examiner respectfully disagrees. Examiner cites MPEP Section 901.02 in which it states "It has also been held that where the reference patent refers to a previously copending but subsequently abandoned application which discloses the subject matter in common with the patent, the effective date of the reference as to the common subject matter is the filing date of the abandoned application." Thus, Tsevdos is prior art with a priority date of 15 October 1993. Further, Examiner has examined 08/763,308 (the abandoned application in question, previously numbered 137,880), and the disclosure and drawings contained within 08/763,308 match exactly the disclosure and drawings set forth in the Tsevdos reference. Thus there is no error as Appellant has purported since all references cited from Patent 5,734,719 exist in the previously abandoned application 137,880, now numbered 08/763,308. AS such the argument is moot.

In Section C of Appellant's arguments, Appellant states:

Appellant primarily argues in section B again that Tsevdos has not been shown to be prior art.

Examiner respectfully disagrees. Examiner cites MPEP Section 901.02 in which it states "It has also been held that where the reference patent refers to a previously copending but subsequently abandoned application which discloses the subject matter

in common with the patent, the effective data of the reference as to the common subject matter is the filing data of the abandoned application." Thus, Tsevdos is prior art with a priority date of 15 October 1993. Further, Examiner has examined 08/763,308 (the abandoned application in question, previously numbered 137,880), and the disclosure and drawings contained within 08/763,308 match exactly the disclosure and drawings set forth in the Tsevdos reference. Thus there is no error as Appellant has purported since all references cited from Patent 5,734,719 exist in the previously abandoned application 137,880, now numbered 08/763,308. AS such the argument is moot.

In Section D of Appellant's arguments, Appellant states:

Appellant primarily argues in section B again that Tsevdos has not been shown to be prior art.

Examiner respectfully disagrees. Examiner cites MPEP Section 901.02 in which it states "It has also been held that where the reference patent refers to a previously copending but subsequently abandoned application which discloses the subject matter in common with the patent, the effective data of the reference as to the common subject matter is the filing data of the abandoned application." Thus, Tsevdos is prior art with a priority date of 15 October 1993. Further, Examiner has examined 08/763,308 (the abandoned application in question, previously numbered 137,880), and the disclosure and drawings contained within 08/763,308 match exactly the disclosure and drawings set forth in the Tsevdos reference. Thus there is no error as Appellant has purported

since all references cited from Patent 5,734,719 exist in the previously abandoned application 137,880, now numbered 08/763,308. AS such the argument is moot.

In Section E of Appellant's arguments, Appellant states:

"Cook does not disclose a plurality of scannable purchase cards each having a unique bar code keyed to the music selection chosen by the customer. There is no disclosure in Cook that the "gift card" is scannable or has a unique bar code keyed to the music selections hosen by the customer."

Examiner respectfully disagrees. As discussed in detail before, for the gift card to function as disclosed by Cook, it would require a number (possibly in the form of a bar code which is notoriously well known in the art) to distinguish it when it was to be redeemed. Cook even states "supplying the gift **number**". It is well known to supply this gift card number to a retail store using a bar code or a scannable magnetic strip. Implementing a scannable number within a bar code instead of a magnetic strip or just keying it in does not produce any new or unexpected result. Thus this limitation does not patentably distinguish the claim from the prior art.

Appellant further alleges:

"There is no disclosure of using any scannable barcode number on the 'gift' certificate keyed to the chosen musical selection"

Examiner respectfully disagrees. When redeeming the gift card, the information contained therein would need to be entered (keyed) into the system. The process of redeeming the gift card through the purchase transaction applies the gift card's value to the purchased tracks, in other words a unique bar code keyed to the music selections chosen by the customer.

In fact, from the specification, Examiner understands that Appellant is using the bar code in the exact same manner as the purchase card disclosed by Cook. Appellant's specification states "In one embodiment of the method, known as to pay first then pick" the customer purchases a purchase card 130 from the retail establishment. The purchase card 130 will be encoded with a unique barcode (or a magnetic strip with store name, billing information, etc.) Cook discloses the exact same method "a customer may purchase (at retail, electronically or otherwise) a 'gift' certificate for a third party, who may then access the service by going to the retail establishment and supplying the gift number or token to the network machine (or an operator thereof). The redemption of these cards "keys" the selections to the numbers. Further the method of storage of that unique number disclosed by Cook is irrelevant as the various methods (barcode, punch number, magnetic strip...) do not provide any new or unexpected result over the other. As such, as further referenced by Appellant's specification, Cook does make obvious these elements of the claims. Furthermore gift cards with unique numbers that are redeemable for purchase are notoriously well known in the art for use in retail environments.

As to Claim 17, claim 17 recites the limitations in question of a plurality of scannable purchase cards (i.e. the gift cards in Cook) each having a unique bar code (i.e. the number on Cook's cards) keyed to the music selections chosen by the customer (i.e. the process of redeeming the card to purchase the tracks. For example, when a user makes a purchase with a credit card, the purchase is applied (keyed) to the credit card. The gift card operates in a similar manner).

In Section F of Appellant's arguments:

In addition to the argument's set forth in Section E of Appellant's Brief which are repeated in Section F, Appellant further states in Section F:

"Separate argument as to claim 18 Cook does not disclose step (a) of the customer obtaining a purchase card with a unique barcode number and an authorized amount from retail premises personnel. Cook does not disclose steps (e), (f), (g), or (h)."

Examiner respectfully disagrees. As to Claim 18, claim 18 recites the limitations in question of the customer obtaining a purchase card with a unique barcode number and an authorized amount from retail premises personnel (i.e. a customer may purchase a gift certificate for a third party in Cook, possibly at a retail location, thus inherently from retail premises personnel. The purchased card would have an inherent value, or in other words an authorized amount) instructing the customer to scan the purchase card at the preview station (i.e. supplying the number to the network machine in Cook), notifying the customer if the total length of all selected tracks exceeds the

Art Unit: 2644

authorized amount on the purchase card (i.e. it is inherent that if there are insufficient funds present, the cashier or machine will notify the customer the card does not have sufficient funds to complete the purchase. This is well known in the art and further is evidenced when a credit card is declined due to insufficient credit. A gift card operates in much of the same manner as a credit card), keying each selected track to the unique barcode (i.e. the process of redeeming the card to purchase the tracks. For example, when a user makes a purchase with a credit card, the purchase is applied (keyed) to the credit card. The gift card operates in a similar manner), scanning the purchase card at a checkout station to obtain the unique barcode (i.e. supplying the number to the network machine in Cook) and recording the selected tracks keyed to the unique barcode on a compact disc cutter (i.e. applying this to the Alexander reference records the purchased tracks to the compact disk).

Appellant further states in Section F:

“Separate argument as to claim 19 Cook does not disclose steps (a), (h), (j), (k), (l) or (q).”

Examiner respectfully disagrees. As to Claim 18, claim 18 recites the limitations in question of the customer obtaining a purchase card with a unique barcode number and an authorized amount from retail premises personnel (i.e. a customer may purchase a gift certificate for a third party in Cook, possibly at a retail location, thus inherently from retail premises personnel. The purchased card would have an inherent

Art Unit: 2644

value, or in other words an authorized amount) instructing the customer to scan the purchase card at the preview station (i.e. supplying the number to the network machine in Cook) notifying the customer if the total length of all selected tracks exceeds the authorized amount on the purchase card (i.e. it is inherent that if there are insufficient funds present, the cashier or machine will notify the customer the card does not have sufficient funds to complete the purchase. This is well known in the art and further is evidenced when a credit card is declined due to insufficient credit. A gift card operates in much of the same manner as a credit card), keying each selected track to the unique barcode (i.e. the process of redeeming the card to purchase the tracks. For example, when a user makes a purchase with a credit card, the purchase is applied (keyed) to the credit card. The gift card operates in a similar manner) scanning the purchase card at a preview station to obtain the unique barcode (i.e. supplying the number to the network machine in Cook) the customer exchanging the purchase card for the recorded compact disc (i.e. applying this to the Alexander reference records the purchased tracks to the compact disk).

Appellant further states in Section F:

"Separate argument as to claim 21. Cook also does not disclose the further limitation of claim 21 of the customer purchasing the purchase card after selecting tracks to be purchased."

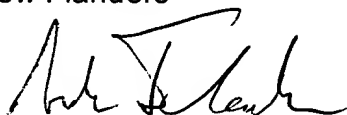
Art Unit: 2644

Examiner respectfully disagrees. The time when the gift card is purchased in the Cook reference for it to be applied is unimportant. For instance, a user may select the tracks, purchase the gift card, and then redeem it or on the other hand, a user may first purchase the gift card, select the tracks and then redeem the card. The order is irrelevant and does not patentably distinguish the claim from the prior art because the order would not produce any new or unexpected result and the reference reads upon the claim language.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Andrew Flanders




Conferees:




XU MEI
PRIMARY EXAMINER

Xu Mei



CURTIS KUNTZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600



VIVIAN CHIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Vivian Chin